

REMARKS

Claims 1-9 are pending. Claims 1 and 4 are independent claims.

By this Amendment, claim 1 is amended for form, and not for substantial reasons for patentability. As discussed below, the rejections of the claims are traversed.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments merely add a coma. Entry of the amendments is thus respectfully requested.

I. Previous Amendment

The previous Amendment revised independent claims 1 and 4 to recite "the protrusion portions have substantially the same height." Applicants argued that Yamada does not disclose or render obvious the subject matter recited in the claims, as amended.

In particular, Yamada discloses a plurality of honeycomb segments joined by a bonding material. See paragraph [0010]. The outer surfaces of the segments are uneven and undulating. See paragraphs [0011] and [0012]. Applicants asserted that Yamada's outer surfaces do not disclose protrusion portions having substantially the same height. Applicants further argued that the "same height" feature of the present application provides uniform moisture amount in the thinner portions of the adhesive layers. Yamada does not disclose these provisions. Also, Yamada does not render obvious the subject matter recited in the claims.

II. Current Office Action

The current Office Action asserts that the amendments and arguments were not persuasive, and makes final the rejections of the claims. In particular, the Office Action rejects claims 1-4, 7 and 8 under 35 U.S.C. §102(b) over EP 1 101 910 to Yamada; and rejects claims 5, 6 and 9 under 35 U.S.C. §103(a) over Yamada. These rejections are respectfully traversed.

A. Office Action's Responses Are Unreasonable

The Office Action asserts a number of counter arguments in the "Response to Arguments" section starting at page 5 of the current Office Action. These Office Action counter arguments are unreasonable, as separately discussed below.

In the first counter argument, the Office Action asserts that the paragraphs of Yamada cited by Applicants do not suggest that each individual undulation is different in height. Further, in the second counter argument, the Office Action asserts that Yamada specifically teaches "the present invention is by no means limited by these examples" at paragraph [0022]. Thus, the Office Action asserts that the teachings of Yamada are not limited by the examples of differing height values.

The first and second counter arguments are unreasonable. Even if true, Yamada's statement "the present invention is by no means limited by these examples" at paragraph [0022] does not establish that Yamada's undulations must have the same height. The claims were amended to recite the "same height" feature. Thus, the burden is on the Patent Office to establish that Yamada discloses this feature. That is, the issue is whether the Patent Office can positively prove that Yamada discloses this feature. The issue is not whether the Applicants can prove that Yamada does not disclose this feature. The Examiner is required to identify specifically where teaching is found to establish *prima facie* case of anticipation, so that Applicants can recognize and seek to counter the grounds for rejection. See Chester v. Miller, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990).

Thus, to establish a *prima facie* case of rejection under anticipation, the burden is on the Patent Office to establish that a reference teaches every element recited in the claims. See the MPEP §2131. Also, if the Patent Office intends to assert subject matter inherently disclosed in the reference, the Patent Office must explain why such subject matter is necessary, and not merely possible, in the reference. See the MPEP §2112(IV).

In the third counter argument, the Office Action admits that Yamada discloses protrusions of different heights. However, the Office Action asserts that this "different height" does not constitute a teaching away from the "same height" feature recited in the claims. However, the previous Amendment did not assert that Yamada teaches away. It appears that the Office Action is attacking the wrong target.

In view of the above, the Office Action's responses to Applicants' arguments are not reasonable.

B. The Rejections Must Be Withdrawn

The Office Action fails to positively establish that Yamada discloses the "same height" recited in independent claims 1 and 4. The Office Action merely asserts that "it is reasonable for one of ordinary skill in the art to believe each undulation in the honeycomb structure is the same height, unless otherwise stated." Such an assertion fails to positively establish that each undulation in Yamada is the same height. The Patent Office cannot assume a reference's disclosure by asserting the absence of contrary disclosure. For example, the Patent Office cannot assume that a reference discloses everything that are not explicitly excluded. As discussed above, the Patent Office bears the burden to explain why each undulation must be of the same height. If the Patent Office relies on the inherency theory, the Patent Office must explain why each undulation is necessarily, not merely possibly, of the same height.

In view of the above, the Office Action fails to positively establish why the undulation of Yamada is of the same height. Thus, the Office Action fails to establish that Yamada discloses each and every element recited in claims 1 and 4. Accordingly, withdrawal of the rejection of claims 1 and 4, and claims 2, 3 and 5-9 depending therefrom, under 35 U.S.C. §102(b) and §103(a) is respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-9 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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